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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/316,908

**Applicant(s)**

KISONO, MASAHIRO

**Examiner**

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/26/04 has been entered.

### *Response to Amendment*

2. Applicant's amendment received on 4/23/04 has been entered and made of record. Currently, **claims 1-20** are pending.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1, 2, 6-8, 12-14, and 18-20** rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Number 6,005,677, cited in the Office action dated 1/23/04) in view of Owens *et al.* (U.S. Patent Number 6,633,630).

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Regarding *claim 1*, Suzuki discloses a method of transmitting an information transfer request from a client data terminal (facsimile device FA1), which is coupled to a local area network (local area networks LN1 and LNk, column 2, line 40 through column 3, line 2, and column 6, line 57 through column 7, line 13), to a called data terminal (facsimile device FAK) which is coupled to the local area network and a public switched telephone network (see Fig. 7), with the method comprising collecting information sets of communication capabilities of a plurality of different data terminals on the local area network at an arbitrary time on the client data terminal (see Fig. 3, and column 2, line 41 through column 3, line 2, and column 4, lines 31 through 45), the different data terminals being coupled to the local area network and the public switched telephone network and including the called data terminal (see Figs. 1 and 7), storing the information sets of communication capabilities into a memory (column 3, line 66 through column 4, line 13), generating on the client data terminal facsimile image information by reference to one of the stored information sets of communication capabilities pertaining to the called data terminal (steps 301-307, column 4, lines 31 through 45, and column 7, lines 23 through 53), creating on the client data terminal an information transfer request for requesting transmission of the facsimile image information to an arbitrary facsimile machine connected to the public telephone network (steps 302-307, column 7, lines 24 through 43), sending the information transfer request from the client data terminal to a communications controller (step 308, column 6, line 57 through column 7, line 4, and column 7, lines 31 through 53, wherein the image information and data is transferred to facsimile device FAK seen in Fig. 7), and transmitting the information transfer request from the communications controller to the called

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data terminal through the local area network upon a completion of the sending step (step 308, column 7, lines 5 through 13, and column 7, lines 43 through 63).

However, Suzuki does not expressly disclose if the facsimile image is generated in accordance with the stored information set of communication capabilities pertaining to the called data terminal, in order for the facsimile image to be acceptable to the called data terminal.

Owens discloses a method of transmitting an information transfer request from a client data terminal (see abstract), which is coupled to a network (X-25 network 18, seen in Figs. 1 and 4), to a called data terminal (message receiver 36) which is coupled to the network (X-25 network 18) and a public switched telephone network (dial-up 52, seen in Fig. 4), with the method comprising collecting information sets of communication capabilities of a plurality of different data terminals on the network at an arbitrary time on the client data terminal (column 3, lines 15 through 58), storing the information sets of communication capabilities into a memory (column 3, lines 15 through 58, wherein rules are stored in filter and forward options for each user), generating on the client data terminal facsimile image information by reference to one of the stored information sets of communication capabilities pertaining to the called data terminal (column 3, lines 15 through 58, and column 10, lines 10 through 56), wherein the facsimile image is generated in accordance with the stored information set of communication capabilities pertaining to the called data terminal, in order for the facsimile image to be acceptable to the called data terminal (column 3, lines 15 through 58, and column 10, lines 10 through 56), creating on the client data terminal an information transfer request for requesting transmission of the facsimile image information to an arbitrary facsimile machine connected to the public telephone network (see Fig. 11 and 14), sending the information transfer request from the client

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data terminal to a communications controller (see Fig. 11 and 14), and transmitting the information transfer request from the communications controller to the called data terminal through the network upon a completion of the sending step (column 10, lines 35 through 56).

Owens & Suzuki are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the rules in the filter and forward options taught by Owens in the conversion table of Suzuki.

The suggestion/motivation for doing so would have been that Suzuki's system would become more user-friendly with the addition of the teachings of Owens, since the message receiver would not risk missing a sender's communication because of a message not being accessible using an alternate communication mode, as well as since the receiver would not be inconvenienced because of switching between communication modes, as recognized by Owens, read in column 1, line 58 through column 2, line 9.

Therefore, it would have been obvious to combine the teachings of Owens with the system of Suzuki to obtain the invention as specified in claim 1.

Regarding **claim 2**, Suzuki and Owens disclose the method discussed above in claim 1, and Suzuki further teaches that the information transfer request includes a telephone number of the arbitrary facsimile machine, the facsimile image information to be transmitted, property information of the facsimile image information, and identification information identifying the called data terminal (column 6, lines 57 through 66, seen in Fig. 8).

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Regarding *claim 6*, Suzuki discloses a client data terminal (facsimile device FA1), which is coupled to a local area network (local area networks LN1 and LNk, column 2, line 40 through column 3, line 2, and column 6, line 57 through column 7, line 13), comprising a first communications device (network controlling apparatus 10, column 3, lines 36 through 46) that generates facsimile image information by reference to information of communication capabilities of a called data terminal to which the first communications device requests to send such facsimile image information ("no" in steps 305 and 313, leading to the process JC, seen in Figs. 9 and 10) and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (column 8, lines 4 through 64), the called data terminal being one of a plurality of different data terminals coupled to the local area network and the public switched telephone network (see Figs. 1 and 7), a memory (parameter memory 3, column 3, lines 11 through 22, and column 3, line 66 through column 4, line 13), and a second communications device (LAN communication controlling unit 11) that performs at an arbitrary time the standard communications operation with at least one of the plurality of different data terminals to receive information sets of communication capabilities of the at least one of the plurality of different data terminals and stores such information into the memory (steps 320 and 321, column 8, lines 44 through 52), that performs the standard facsimile communications operation with the first communications device to send from the memory one of the information sets of communication capabilities which pertain to the called data terminal (process JC, seen in Fig. 10), and that performs the standard facsimile communications operation, using the information transfer request received from the first communications device

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(steps 306-309, and 314-317, column 7, line 36 through column 8, line 29), with the called data terminal through the local area network after completing the standard facsimile communications operation with the first communications device (steps 306-309, and 314-317, column 7, line 36 through column 8, line 29, whereby these process steps occur at a subsequent time when a transmission is initiated to a destination telephone number now stored in the telephone number conversion table), the second communications device being operatively connected to the first communications device (see Fig. 2) and to the plurality of different data terminals via the local area network (see Figs. 1 and 7).

However, Suzuki does not expressly disclose if the first communications device generates the facsimile image in accordance with the information of communication capabilities of the called data terminal, in order for the facsimile image to be acceptable to the called data terminal.

Owens discloses a client data terminal (communications server 28, see Fig. 1), which is coupled to a network (X-25 network 18, see Figs. 1 and 4), comprising a first communications device that generates facsimile image information by reference to information of communication capabilities of a called data terminal to which the first communications device requests to send such facsimile image information (column 3, lines 15 through 58, and column 10, lines 10 through 56) and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (see abstract, and Fig. 7), and a memory (column 3, lines 15 through 58, wherein rules are stored in filter and forward options for each user), wherein the first communications device generates the facsimile image in accordance with the information of communication capabilities of the called data



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terminal, in order for the facsimile image to be acceptable to the called data terminal (column 3, lines 15 through 58, and column 10, lines 10 through 56).

Owens & Suzuki are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the rules in the filter and forward options taught by Owens in the conversion table of Suzuki.

The suggestion/motivation for doing so would have been that Suzuki's system would become more user-friendly with the addition of the teachings of Owens, since the message receiver would not risk missing a sender's communication because of a message not being accessible using an alternate communication mode, as well as since the receiver would not be inconvenienced because of switching between communication modes, as recognized by Owens, read in column 1, line 58 through column 2, line 9.

Therefore, it would have been obvious to combine the teachings of Owens with the system of Suzuki to obtain the invention as specified in claim 6.

Regarding *claim 7*, Suzuki and Owens disclose the terminal discussed above in claim 6, and Suzuki further teaches that the second communications device controls the standard facsimile communication operation with the first communications device to perform throughout a plurality of facsimile communications steps which are defined as phases A through to E in accordance with a Group 3 facsimile communications procedure (column 3, lines 36 through 42, and column 4, line 65 through column 5, line 13, and column 8, lines 31 through 64, wherein the phases A through E are inherently included in a Group 3 communication).

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Regarding **claim 8**, Suzuki and Owens disclose the terminal discussed above in claim 6, and Suzuki further teaches that the information transfer request includes a telephone number of the arbitrary facsimile machine, the facsimile image information to be transmitted, property information of the facsimile image information, and identification information identifying the called data terminal (column 6, lines 57 through 66, seen in Fig. 8).

Regarding **claim 12**, Suzuki discloses a client data terminal (facsimile device FA1), which is coupled to a local area network (local area networks LN1 and LNk, column 2, line 40 through column 3, line 2, and column 6, line 57 through column 7, line 13), comprising a first communications means (network controlling apparatus 10, column 3, lines 36 through 46) for generating facsimile image information by reference to information of communication capabilities of a called data terminal to which the first communications device requests to send such facsimile image information ("no" in steps 305 and 313, leading to the process JC, seen in Figs. 9 and 10) and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (column 8, lines 4 through 64), the called data terminal being one of a plurality of different data terminals coupled to the local area network and the public switched telephone network (see Figs. 1 and 7), a memory means (parameter memory 3, column 3, lines 11 through 22, and column 3, line 66 through column 4, line 13), and a second communications means (LAN communication controlling unit 11) for performing at an arbitrary time the standard communications operation with at least one of the plurality of different data terminals to receive information sets of communication capabilities of the at least one of the plurality of different data terminals and

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stores such information into the memory means (steps 320 and 321, column 8, lines 44 through 52), performing the standard facsimile communications operation with the first communications means to send from the memory means one of the information sets of communication capabilities which pertain to the called data terminal (process JC, seen in Fig. 10), and performing the standard facsimile communications operation with the first communications means to receive the information transfer request, and performing the standard facsimile communications operation, using the information transfer request received from the first communications means (steps 306-309, and 314-317, column 7, line 36 through column 8, line 29), with the called data terminal through the local area network after completing the standard facsimile communications operation with the first communications means (steps 306-309, and 314-317, column 7, line 36 through column 8, line 29, whereby these process steps occur at a subsequent time when a transmission is initiated to a destination telephone number now stored in the telephone number conversion table), the second communications means being operatively connected to the first communications means (see Fig. 2) and to the plurality of different data terminals via the local area network (see Figs. 1 and 7).

However, Suzuki does not expressly disclose if the first communications device generates the facsimile image in accordance with the information of communication capabilities of the called data terminal, in order for the facsimile image to be acceptable to the called data terminal.

Owens discloses a client data terminal (communications server 28, see Fig. 1), which is coupled to a network (X-25 network 18, see Figs. 1 and 4), comprising a first communications means for generating facsimile image information by reference to information of communication capabilities of a called data terminal to which the first communications device requests to send

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such facsimile image information (column 3, lines 15 through 58, and column 10, lines 10 through 56) and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (see abstract, and Fig. 7), and a memory means (column 3, lines 15 through 58, wherein rules are stored in filter and forward options for each user), wherein the first communications means generates the facsimile image in accordance with the information of communication capabilities of the called data terminal, in order for the facsimile image to be acceptable to the called data terminal (column 3, lines 15 through 58, and column 10, lines 10 through 56).

Owens & Suzuki are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the rules in the filter and forward options taught by Owens in the conversion table of Suzuki.

The suggestion/motivation for doing so would have been that Suzuki's system would become more user-friendly with the addition of the teachings of Owens, since the message receiver would not risk missing a sender's communication because of a message not being accessible using an alternate communication mode, as well as since the receiver would not be inconvenienced because of switching between communication modes, as recognized by Owens, read in column 1, line 58 through column 2, line 9.

Therefore, it would have been obvious to combine the teachings of Owens with the system of Suzuki to obtain the invention as specified in claim 12.

Regarding **claim 13**, Suzuki and Owens disclose the terminal discussed above in claim 12, and Suzuki further teaches that the second communications means controls the standard facsimile communication operation with the first communications means to perform throughout a plurality of facsimile communications steps which are defined as phases A through to E in accordance with a Group 3 facsimile communications procedure (column 3, lines 36 through 42, and column 4, line 65 through column 5, line 13, and column 8, lines 31 through 64, wherein the phases A through E are inherently included in a Group 3 communication).

Regarding **claim 14**, Suzuki and Owens disclose the terminal discussed above in claim 12, and Suzuki further teaches that the information transfer request includes a telephone number of the arbitrary facsimile machine, the facsimile image information to be transmitted, property information of the facsimile image information, and identification information identifying the called data terminal (column 6, lines 57 through 66, seen in Fig. 8).

Regarding **claim 18**, Suzuki and Owens disclose the method discussed above in claim 1, and Suzuki further teaches that the one of the information sets of communication capabilities pertaining to the called data terminal is used to generate the facsimile image information in a format acceptable to the called data terminal (column 4, line 31 through column 5, line 28, whereby the facsimile image information is generated into either a format for Internet communication or a format for communication over the GSTN, based on if a specified called terminal includes an IP address in the conversion table, thereby having an internet communication capability).

Regarding **claim 19**, Suzuki and Owens disclose the terminal discussed above in claim 6, and Suzuki further teaches that the information of communication capabilities of the called data

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terminal is used to generate the facsimile image information in a format acceptable to the called data terminal (column 4, line 31 through column 5, line 28, whereby the facsimile image information is generated into either a format for Internet communication or a format for communication over the GSTN, based on if a specified called terminal includes an IP address in the conversion table, thereby having an internet communication capability).

Regarding **claim 20**, Suzuki and Owens disclose the terminal discussed above in claim 12, and Suzuki further teaches that the information of communication capabilities of the called data terminal is used to generate the facsimile image information in a format acceptable to the called data terminal (column 4, line 31 through column 5, line 28, whereby the facsimile image information is generated into either a format for Internet communication or a format for communication over the GSTN, based on if a specified called terminal includes an IP address in the conversion table, thereby having an internet communication capability).

5. **Claims 3, 4, 9, 10, 15, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Number 6,005,677, cited in the Office action dated 1/23/04) in view of Owens *et al.* (U.S. Patent number 6,633,630), and further in view of Fite, Jr. *et al.* (U.S. Patent Number 5,517,324, cited in the Office action dated 1/23/04).

Regarding **claim 3**, Suzuki and Owens disclose the method discussed above in claim 2, and Suzuki further teaches that the information sets of communication capabilities of the different data terminals collected in the collecting step includes information identifying at least a connection for specifying one of the registered different data terminals (column 3, line 66

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through column 4, line 13, seen in Fig. 3, being the connection to the IP or e-mail address), and encoding/decoding functions (column 7, lines 40 through 53).

However, Suzuki and Owens fail to expressly disclose if the information sets of communication capabilities of the different data terminals collected in the collecting step also include an image resolution, and a recording sheet size.

Fite discloses a method of transmitting an information transfer request from a client data terminal (fax machine 12, seen in Fig. 1, column 4, lines 26 through 49), which is coupled to a called data terminal (fax machines 24), with the method comprising the steps of collecting information sets of communication capabilities of a plurality of different data terminals at an arbitrary time on the client data terminal (column 5, line 3 through column 6, line 11), the different data terminals being coupled to a network and including the called data terminal (see Fig. 1), generating on the client data terminal facsimile image information by reference to one of the information sets of communication capabilities pertaining to the called data terminal (column 11, line 3 through column 12, line 51), and transmitting the information to the called data terminal (column 12, lines 1 through 44). Fite further teaches that the information sets of communication capabilities of the different data terminals collected in the collecting step includes information identifying at least a connection for specifying one of the registered different data terminals, an image resolution, a recording sheet size, encoding/decoding functions (column 7, line 21 through column 8, line 34).

Suzuki, Owens & Fite are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the communication capabilities taught by Fite in the conversion table of Suzuki.

The suggestion/motivation for doing so would have been that the system of Suzuki and Owens would become more user-friendly with the addition of the teachings of Fite, since the data terminals would have support of enhanced capabilities, as recognized by Fite, read in column 2, lines 3 through 67, which would therein conform to standards well-known throughout the art.

Therefore, it would have been obvious to combine the teachings of Fite with the system of Suzuki and Owens to obtain the invention as specified in claim 3.

Regarding *claim 4*, Suzuki and Owens disclose the method discussed above in claim 2, but fail to expressly disclose of judging whether the facsimile image information to be transmitted has been encoded using an encoding function which is lower grade than the encoding/decoding functions of the stored information set, and converting the facsimile image information to be transmitted using the encoding/decoding functions registered in the memory during the storing step when a result of the judging step determines that the facsimile image information to be transmitted is lower grade.

Fite discloses a method (discussed above with respect to claim 3), further teaching of the steps of judging whether the facsimile image information to be transmitted has been encoded using an encoding function which is lower grade than the encoding/decoding functions of the stored information set, and converting the facsimile image information to be transmitted using the encoding/decoding functions registered in the memory during the storing step when a result



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of the judging step determines that the facsimile image information to be transmitted is lower grade (column 7, lines 1 through 34, column 12, lines 32 through 44, and column 13, lines 20 through 34).

Suzuki, Owens & Fite are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the communication capabilities taught by Fite in the conversion table of Suzuki.

The suggestion/motivation for doing so would have been that the system of Suzuki and Owens would become more user-friendly with the addition of the teachings of Fite, since the data terminals would have support of enhanced capabilities, as recognized by Fite, read in column 2, lines 3 through 67, which would therein conform to standards well-known throughout the art.

Therefore, it would have been obvious to combine the teachings of Fite with the system of Suzuki and Owens to obtain the invention as specified in claim 4.

Regarding **claim 9**, Suzuki and Owens disclose the terminal discussed above in claim 6, and Suzuki further teaches that the information sets of communication capabilities of the different data terminals sent from the first communications device to the second communications device includes information identifying at least a connection for specifying one of the registered different data terminals (column 3, line 66 through column 4, line 13, seen in Fig. 3, being the connection to the IP or e-mail address), and encoding/decoding functions (column 7, lines 40 through 53).

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However, Suzuki and Owens fail to expressly disclose if the information sets of communication capabilities of the different data terminals also include an image resolution, and a recording sheet size.

Fite discloses a client data terminal (fax machine 12, seen in Fig. 1, column 4, lines 26 through 49), comprising a first communications device that generates facsimile image information by reference to information of communication capabilities of a called data terminal (fax machines 24) to which the first communications device requests to send such facsimile image information and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (column 11, lines 11 through 67), the called data terminal being one of a plurality of different data terminals coupled to the public switched telephone network (see Fig. 1), and a second communications device that performs at an arbitrary time the standard communications operation with at least one of the plurality of different data terminals to receive information sets of communication capabilities of the at least one of the plurality of different data terminals (column 5, line 3 through column 6, line 11). Fite further teaches that the information sets of communication capabilities of the different data terminals includes information identifying at least a connection for specifying one of the registered different data terminals, an image resolution, a recording sheet size, encoding/decoding functions (column 7, line 21 through column 8, line 34).

Suzuki, Owens & Fite are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the communication capabilities taught by Fite in the conversion table of Suzuki.

The suggestion/motivation for doing so would have been that the system of Suzuki and Owens would become more user-friendly with the addition of the teachings of Fite, since the data terminals would have support of enhanced capabilities, as recognized by Fite, read in column 2, lines 3 through 67, which would therein conform to standards well-known throughout the art.

Therefore, it would have been obvious to combine the teachings of Fite with the system of Suzuki and Owens to obtain the invention as specified in claim 9.

Regarding *claim 10*, Suzuki and Owens disclose the terminal discussed above in claim 6, but fail to expressly disclose if the second communications device can convert the information transfer request sent from the first communications device, using the encoding/decoding functions registered in the memory as the information of communication capabilities of the called data terminal, when an encoding function used by the first communications device for conversion of the information transfer request is lower grade than the registered encoding/decoding functions.

Fite discloses a terminal (discussed above with respect to claim 9), further teaching that the second communications device can convert the information transfer request sent from the first communications device, using the encoding/decoding functions registered in the memory as the information of communication capabilities of the called data terminal, when an encoding function used by the first communications device for conversion of the information transfer

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request is lower grade than the registered encoding/decoding functions (column 7, lines 1 through 34, column 12, lines 32 through 44, and column 13, lines 20 through 34).

Suzuki, Owens & Fite are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the communication capabilities taught by Fite in the conversion table of Suzuki.

The suggestion/motivation for doing so would have been that the system of Suzuki and Owens would become more user-friendly with the addition of the teachings of Fite, since the data terminals would have support of enhanced capabilities, as recognized by Fite, read in column 2, lines 3 through 67, which would therein conform to standards well-known throughout the art.

Therefore, it would have been obvious to combine the teachings of Fite with the system of Suzuki and Owens to obtain the invention as specified in claim 10.

Regarding **claim 15**, Suzuki and Owens disclose the terminal discussed above in claim 12, and Suzuki further teaches that the information sets of communication capabilities of the different data terminals sent from the first communications means to the second communications means includes information identifying at least a connection for specifying one of the registered different data terminals (column 3, line 66 through column 4, line 13, seen in Fig. 3, being the connection to the IP or e-mail address), and encoding/decoding functions (column 7, lines 40 through 53).

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However, Suzuki and Owens fail to expressly disclose if the information sets of communication capabilities of the different data terminals also include an image resolution, and a recording sheet size.

Fite discloses a client data terminal (fax machine 12, seen in Fig. 1, column 4, lines 26 through 49), comprising a first communications means that generates facsimile image information by reference to information of communication capabilities of a called data terminal (fax machines 24) to which the first communications means requests to send such facsimile image information and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (column 11, lines 11 through 67), the called data terminal being one of a plurality of different data terminals coupled to the public switched telephone network (see Fig. 1), and a second communications means that performs at an arbitrary time the standard communications operation with at least one of the plurality of different data terminals to receive information sets of communication capabilities of the at least one of the plurality of different data terminals (column 5, line 3 through column 6, line 11). Fite further teaches that the information sets of communication capabilities of the different data terminals includes information identifying at least a connection for specifying one of the registered different data terminals, an image resolution, a recording sheet size, encoding/decoding functions (column 7, line 21 through column 8, line 34).

Suzuki, Owens & Fite are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the communication capabilities taught by Fite in the conversion table of Suzuki.

The suggestion/motivation for doing so would have been that the system of Suzuki and Owens would become more user-friendly with the addition of the teachings of Fite, since the data terminals would have support of enhanced capabilities, as recognized by Fite, read in column 2, lines 3 through 67, which would therein conform to standards well-known throughout the art.

Therefore, it would have been obvious to combine the teachings of Fite with the system of Suzuki and Owens to obtain the invention as specified in claim 15.

Regarding *claim 16*, Suzuki and Owens disclose the terminal discussed above in claim 12, but fail to expressly disclose if the second communications means can convert the information transfer request sent from the first communications means, using the encoding/decoding functions registered in the memory means as the information of communication capabilities of the called data terminal, when an encoding function used by the first communications means for conversion of the information transfer request is lower grade than the registered encoding/decoding functions.

Fite discloses a terminal (discussed above with respect to claim 15), further teaching that the second communications means can convert the information transfer request sent from the first communications means, using the encoding/decoding functions registered in the memory as the information of communication capabilities of the called data terminal, when an encoding function used by the first communications means for conversion of the information transfer

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request is lower grade than the registered encoding/decoding functions (column 7, lines 1 through 34, column 12, lines 32 through 44, and column 13, lines 20 through 34).

Suzuki, Owens & Fite are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the communication capabilities taught by Fite in the conversion table of Suzuki.

The suggestion/motivation for doing so would have been that the system of Suzuki and Owens would become more user-friendly with the addition of the teachings of Fite, since the data terminals would have support of enhanced capabilities, as recognized by Fite, read in column 2, lines 3 through 67, which would therein conform to standards well-known throughout the art.

Therefore, it would have been obvious to combine the teachings of Fite with the system of Suzuki and Owens to obtain the invention as specified in claim 16.

6. **Claims 5, 11, and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Number 6,005,677, cited in the Office action dated 1/23/04) in view of Owens *et al.* (U.S. Patent number 6,633,630), and further in view of Westwick *et al.* (U.S. Patent Number 5,828,836, cited in the Office action dated 1/23/04).

Regarding **claim 5**, Suzuki and Owens disclose the method discussed above in claim 1, but fail to expressly disclose if the communications controller has a default condition in which the communications controller is normally conditioned to send the information transfer request to

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a specific data terminal from among the different data terminals in the memory, and can be released from the default condition and be set to a different data terminal when the client data terminal specifies another called data terminal to send the information transfer request.

Westwick discloses a method of transmitting an information transfer request from a client data terminal (host processor 12), which is coupled to a local area network (LAN 16), to a called data terminal (I/O devices 18A-18N, seen in Fig. 1) which is coupled to the local area network and a public switched telephone network (PSTN 19), with the method comprising collecting information sets of communication capabilities of a plurality of different data terminals on the local area network at an arbitrary time on the client data terminal (column 4, lines 7 through 26), the different data terminals being coupled to the local area network and the public switched telephone network and including the called data terminal (see Fig. 1), storing the information sets of communication capabilities into a memory (on-line storage 24, column 4, lines 12 through 14), generating on the client data terminal facsimile image information by reference to one of the stored information sets of communication capabilities pertaining to the called data terminal (column 9, lines 1 through 67), creating on the client data terminal an information transfer request for requesting transmission of the facsimile image information to an arbitrary facsimile machine connected to the public telephone network (column 8, lines 43 through 59, and column 9, lines 1 through 10), sending the information transfer request from the client data terminal to a communications controller (controller 14A-14N, column 8, lines 50 through 59), and transmitting the information transfer request from the communications controller (controller 14A-14N) to the called data terminal through the local area network upon a completion of the sending step (column 8, lines 50 through 67). Further, Westwick teaches that the



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communications controller has a default condition in which the communications controller is normally conditioned to send the information transfer request to a specific data terminal from among the different data terminals in the memory (column 5, line 33 through column 6, line 23), and can be released from the default condition and be set to a different data terminal when the client data terminal specifies another called data terminal to send the information transfer request (column 6, lines 16 through 41).

Suzuki, Owens & Westwick are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate using default conditions for the communications controller as taught by Westwick in the system of Suzuki and Owens.

The suggestion/motivation for doing so would have been that the system of Suzuki and Owens would become more efficient with the addition of the teachings of Westwick, since a normal condition is stored as a default, which can be released at certain times, as recognized by Westwick, read in column 6, lines 1 through 30.

Therefore, it would have been obvious to combine the teachings of Westwick with the system of Suzuki and Owens to obtain the invention as specified in claim 5.

Regarding *claims 11 and 17*, Suzuki and Owens disclose the terminals discussed above in claims 6 and 12, but fail to expressly disclose if the first communications device has a default condition in which the first communications device is normally conditioned to send the information transfer request to a specific data terminal from among the different data terminals in

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the memory, and can be released from the default condition and be set to a different data terminal when the first communications device specifies another called data terminal.

Westwick discloses a client data terminal (host processor 12), which is coupled to a local area network (LAN 16), comprising a first communications device that generates facsimile image information by reference to information of communication capabilities of a called data terminal to which the first communications device requests to send such facsimile image information (column 8, lines 43 through 67, and column 9, lines 27 through 64) and then performs a standard facsimile communications operation with respect to an information transfer request for requesting a transmission of the facsimile image information to an arbitrary facsimile machine connected to a public switched telephone network (PSTN 19, seen in Fig. 1, column 3, line 63 through column 4, line 26), the called data terminal being one of a plurality of different data terminals coupled to the local area network and the public switched telephone network (I/O devices 18B-18N, see Fig. 1), a memory (on-line storage 24, column 4, lines 12 through 14), and a second communications device (data director 20, column 4, lines 7 through 26, and column 9, lines 29 through 52) that performs at an arbitrary time the standard communications operation with at least one of the plurality of different data terminals to receive information sets of communication capabilities of the at least one of the plurality of different data terminals and stores such information into the memory (column 2, lines 29 through 61, column 5, line 6 through column 6, line 41, and column 10, lines 15 through 51), that performs the standard facsimile communications operation with the first communications device to send from the memory one of the information sets of communication capabilities which pertain to the called data terminal (column 9, lines 1 through 10), and that performs the standard facsimile

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communications operation, using the information transfer request received from the first communications device (column 8, line 50 through column 9, line 10), with the called data terminal through the local area network after completing the standard facsimile communications operation with the first communications device (column 2, line 29 through column 3, line 19), the second communications device being operatively connected to the first communications device and to the plurality of different data terminals via the local area network (see Fig. 1). Further, Westwick teaches that the first communications device has a default condition, in which the first communications device is normally conditioned to send the information transfer request to a specific data terminal from among the different data terminals in the memory (column 5, line 33 through column 6, line 23), and can be released from the default condition and be set to a another different data terminal when the first communications device specifies another called data terminal (column 6, lines 16 through 41).

Suzuki, Owens & Westwick are combinable because they are from the same field of endeavor, being systems that transmit facsimile messages.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate using default conditions for the communications controller as taught by Westwick in the system of Suzuki and Owens.

The suggestion/motivation for doing so would have been that the system of Suzuki and Owens would become more efficient with the addition of the teachings of Westwick, since a normal condition is stored as a default, which can be released at certain times, as recognized by Westwick, read in column 6, lines 1 through 30.

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Therefore, it would have been obvious to combine the teachings of Westwick with the system of Suzuki and Owens to obtain the invention as specified in claims 11 and 17.

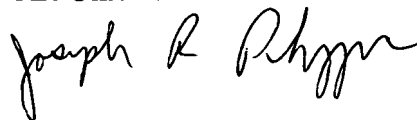
***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa  
Examiner  
Art Unit 2622



jrp